

What is remarkable about the extensive prosecution history of this case is that three Supervisors have allowed Examiner Steven R. Wasylchak to fail to meet his burden as Examiner, to follow the principles of compact prosecution. Instead this Examiner has conducted a partial and incomplete examination in each round of examination. This has resulted in extra costs for the applicant to continue the prosecution. Specifically applicant wants the Examiner and his Supervisors to note the following from MPEP 2164.04:

In accordance with the principles of compact prosecution, if the enablement rejection is appropriate, the first Office Action on the merits should present the best case with all the relevant reasons, issues, and evidence so that all such rejections can be withdrawn if applicant provides appropriate convincing arguments and/or evidence in rebuttal. Providing the best case in the first Office Action will also allow the Second Office Action to be made final should applicant fail to provide appropriate convincing arguments and/or evidence. Citing new references and/or expanding arguments in the second Office Action could prevent that Office Action from being made final....

The Sixth Office Action mailed on May 5, 2004, clearly expands new arguments by raising a new rejection based on the "view of portability" citing In re Lindberg, 194 F.2d 732, 93 USPQ 23 (CCPA 1952). Applicants submits the following rebuttal to paragraphs 2 to 4 of the Office Action.

REMARKS

Claims 1 through 12 are under consideration. Reconsideration of all claims is respectfully requested.

In #2, the Office Action states that the word "*intercooperate*" *does not exist in the English language*. This facetious remark is unwarranted. Applicant refers the Examiner to the source of this word- the MPEP on page 2100-198, Sec 2172.01, last line. Applicant quoted the word "intercoopratc" from the last line of this section. As to this

Examiner's statement that applicant should read the disclosure carefully, applicant assures the Examiner that there are no errors of grammar in applicant's disclosure.

In #3 the Action states:

" While a time line per se has not been presented as requested, examiner has much grasp of the claims with the new flowchart and such request is in abeyance."

First, the Action should use correct grammar. Second, the Examiner should follow the principle of compact prosecution and not let the prosecution proceed to the round of RCE filing.

In response, applicant submitted a detailed timeline in the Response Filed on January 28, 2004. If it is beyond the examiner's competence to comprehend applicant's Response, then the examiner should cease to Examine this case. Examiner's Supervisor should assign the case to an Examiner with the proper training in the art.

In #4 the Action states:

"Examiner notes that a pin number, a term omitted throughout the disclosure, is equivalent to "password". Examiner has considered Applicant's arguments and respectfully finds them unpersuasive. In essence, Examiner has come to the conclusion that the Applicant has, in effect, devised a method of internet shopping using a portable I/O device such as a client dedicated smart card that acts as a portable ATM attached to a personal computer. From the point of view of portability, In re Lindberg, 194 F. 2d 732, 93 USPQ 23 (CCPA 1952), states that portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new and unexpected results."

In response, applicant strongly disagrees. The Section in MPEP that cites In re Lindberg, is MPEP 2144.04 V. This Section clearly states that the legal precedent that can be cited as Supporting Rational must have sufficiently similar facts to those facts in the application under examination. " *If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. If the applicant has demonstrated the criticality of a specific limitation, it would be inappropriate to rely solely on case law as the rationale to support an obviousness rejection.*"

The facts in In re Lindberg are very different from facts in the present application. Lindberg's device comprised a power sprayer adapted to be mounted on farm machinery. The Patent Office cited seven references and applied combinations of these references to reject the claims as obvious. (A copy of the case is submitted). The appealed claims did not recite any novel feature over cited art and the only difference was that the old device was not portable and the new device was portable. The CCPA held that without a novel feature, or a new and unexpected result, Lindberg's device was not patentable.

The facts in the present case indicate that the present invention possesses several novel features which are neither present nor suggested in Kolling. For example, 1) the step where the customer installs software that corresponds to the I/O device onto his/her computer, 2) the step in the invention where data are sent from two different locations, the customer's computer and the merchant's website, and 3) the step that data must be validated between customer's and merchant's locations--- are not present in Kolling. Each of these distinct aspects of the invention serves as a substantive reason to overcome the 102 rejections.

Among the elements that clearly distinguish the invention from the reference is that personal financial information is not accessible at the time of the transaction because the I/O device acts as the sole source of validation necessary for the transaction on behalf of the client. For example, the purchasing of the I/O device may require the connection to personal financial information; the purpose of the I/O device is to allow the personal financial information to be severed from the transaction. Once the I/O device is purchased there is not a further need for a client to send, nor is there a need for a merchant to request personal financial information.

The MAIN ADVANTAGE OF THIS NOVEL FEATURE IS SECURITY. The problem of identity theft at ATM locations is enormous, and the present invention solves this problem. Therefore, based on Lindberg, the facts in the present application indicate the presence of novel features to distinguish Kolling. Additionally, the present invention has unexpected results because it provides security to the user and solves the problem of identity theft so common at ATM machines.

Therefore, as a matter of fact and law, there is no basis to sustain the rejection of claims 1 to 12 based on Lindberg. This rejection must be withdrawn.

In #5 to #7, the Office Action reproduces the Claim Rejections Under 35 USC Sec 102 from the Office Action of June 10, 2003. Applicant responded to this rejection in his Response dated October 3, 2003 as follows:

35 U.S.C. § 102 (b) Rejections: The Examiner rejected claims 1-12 under 35 U.S.C. § 102 (b) as being anticipated by Kolling et al (US 5,920,847). The Rejection of June 10, 2003 is repeated.

Examiner's comment that *separation limitation appears to be at the core of applicant's invention and is traversed by fig 19B where there is no personal financial information link between the consumer's I/O device and the merchant (biller) during the execution of this transaction because there is no link or directional arrow between the consumer and the biller merchant during the transaction* is unjustified as there is no specific mention of the separation of personal financial information from the transaction at any point in the specification or claims of Kolling.

The Examiner's assumption is wrong because the lack of a line connecting the source of the funds and their destination does not mean that the information is not transmitted. In fact, ATM or credit card transactions are executed via the transmission of account numbers and pin numbers. The detailed description of the drawing refers to credit and debits of the ACH account, this could only be done if the account number was disclosed, as there is no device that operates as a means of separating the account from the transaction, as the I/O device does in the invention. This is the case with Kolling, where personal financial information would have to be transmitted for the transfer to be successfully completed. Any attempted transfer where personal financial information is not transmitted would result in a failed transaction, as the transmission of said information is an essential element of the Kolling system. In the invention there is a separation, as the I/O device does not retain the number of the account from which it was authorized/drawn. The Examiner appears to have improperly applied hindsight reasoning, based on applicant's own disclosure. Such hindsight is not permitted under Section 102 or 103 rejections.

The present invention possesses several factors which are neither present nor suggested in Kolling, the step where the customer installs software that corresponds to the I/O device onto his/her computer and the step in the invention where data sent from two different location, the customer's computer and the merchant's website, must validate each other are not present in Kolling. Each of these distinct aspects of the invention serves as a substantive reason to overcome the 102 rejections.

Among the elements that clearly distinguish the invention from the reference is that personal financial information is not accessible at the time of the transaction because the I/O device acts as the sole source of validation necessary for the transaction on behalf of the client. For example, the purchasing of the I/O device may require the connection to personal financial information; the purpose of the I/O device is to allow the personal financial information to be severed from the transaction. Once the I/O device is purchased there is not a further need for a client to send, nor is there a need for a merchant to request personal financial information.

As disclosed on page 12 of the original specification in regard to the detailed description of Fig. 5, the invention includes a step wherein the I/O device is attached to the parallel port on the client's computer and the necessary software step is installed. This aspect of the invention is entirely novel and heretofore not used in the field. This step is included in the timeline requested by the examiner as a means of further describing process, which had previously been disclosed in the specification. No new matter has been added.

As disclosed on page 14 of the original specification in regard to the detailed description of Fig. 5, the final step in the execution of the transaction occurs when the

merchant's website and the client's computer send information packets, which must validate each other, to the financial institution. This means of validation is neither mentioned nor suggested at any point in Kolling.

According to the case law, for a rejection to be upheld under section 102(b) of 35 USC, "...every element of the claimed invention must be identically shown in a single reference'...these elements must be arranged as in claim under review" (In re Bond, 910 F.2nd 831, 15 USPQ 2nd 1566). Therefore, under In re Bond, the cited art does not anticipate the prior invention. This is because three essential element of the present invention—the separation of personal financial information from the transaction, the installation of software onto the client's computer, and the validation of two data packets—are not present in the cited prior art. There is no mention is the detailed description of figure 19B of the separation of personal financial information from the transaction. Nor, for that matter, is there any mention in the specification of said essential element of the instant invention. Therefore, this rejection should be withdrawn.

Respectfully Submitted,

Rashida A. Karmali

Rashida A. Karmali, Esq.

Reg. No. 43,705

99 Wall Street, 13th Floor

New York, NY 10005

Phone (212) 651-9653

Fax (212) 651-9654



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In re Lindberg

Appl. No. 5832

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

39 C.C.P.A. 866; 194 F.2d 732; 1952 CCPA LEXIS 281; 93 U.S.P.Q. (BNA) 23

February 18, 1952, Decided

DISPOSITION: [*1] Appeal from Board of Appeals of the Patent Office.

Application for patent of Peter H. Lindberg, Serial No. 601,409; Patent Office Division 30. From decision rejecting claims 3 to 5, applicant appeals. Affirmed.

COUNSEL: Myron J. Dikeman, Detroit, Mich., for appellant.

E. L. Reynolds (H. S. Miller of counsel) for Commissioner of Patents.

OPINIONBY: Johnson, Judge.

OPINION: This is an appeal from the decision of the Board of Appeals of the United States Patent Office. The board's decision affirmed the holding of the Primary Examiner rejecting as unpatentable claims 3, 4, and 5, the only remaining claims in appellant's application for a patent on a "Power Sprayer."

Appellant's device comprises a power sprayer adapted to be mounted on farm machinery such as a cultivator or tractor for use in spraying crops. The device, as disclosed by appellant, includes a cylindrical liquid spray tank having a spray agitator rotatably mounted therein. Mounted on top of the tank are a small gasoline engine and a conventional type dual hydraulic pump unit, both pumps of the unit being driven together by the engine through a single belt and pulley system. The inlet of one of the pumps is connected to the [*2] spray tank and the outlet is connected by suitable pipe means to a spray nozzle of appropriate design. On the outlet side of this pump there are also a shut-off valve and a relief valve for controlling flow to the sprayer, and a by-pass arrangement whereby the spray liquid is returned to the tank when the shut-off valve is closed or excessive pressure is developed. On one end of the tank there are mounted a liquid oil tank and an oil-operated hydraulic driving unit which is operatively connected to the spray agitator mounted in the tank so as to rotate it when the driving unit is actuated. The inlet of the second pump of the dual pump unit is connected by suitable pipe means to the oil tank and its outlet is connected to the input side of the oil-operated agitator driving unit, with the outlet side of the driving unit being in turn

connected to the oil tank to complete the hydraulic system.

The operation of the above-described device is as follows: When the engine is started both pumps of the dual pump unit are driven. The first pump causes the spray liquid to be pumped from the tank to the discharge spray nozzle if the shut-off valve is open; if that valve is closed, the [*3] spray liquid will pass back into the tank through the by-pass arrangement. At the same time, the second pump causes oil to circulate in a closed circuit from the oil tank through that pump and the hydraulically driven agitator drive unit and back to the oil tank, thus rotating the agitator in the spray tank in order to keep the spray mixture therein uniformly mixed.

Appellant also discloses a modification which has only a single pump unit for pumping the spray liquid from the tank. Instead of the above-described hydraulic drive system for rotating the agitator, this modification has a pulley mounted on the tank, said pulley being driven from the motor and being connected by means of a belt to another pulley mounted on the agitator shaft, whereby rotation of the motor produces rotation of the agitator.

Claims 3 and 5, which are considered representative of the appealed claims, read as follows:

3. A power spraying device, and used with the farm maching [sic] vehicle, comprising a liquid spray tank, a liquid agitator rotatably mounted within said tank, said agitator being provided with a suitable hydraulic driving unit mounted on one end thereof, dual hydraulic pumps [*4] fixedly mounted on the liquid spray tank, rotating power means mounted on said tank, means for operatively connecting the power means with the dual pump units for operating same, a liquid oil tank fixedly mounted on said liquid spray tank, pipe means for operatively connecting one of the pump inlets with said liquid oil tank and opening therein, and pipe means for connecting the outlet of the same pump unit to the tank agitator driving unit inlet and returning therefrom to the said oil tank, pipe means for connecting the inlet of the other pump unit with the chamber of the liquid spray tank, and pipe means for connecting the discharge outlet of the same pump, a spray nozzle mounted on said discharge pipe.

5. A power spraying device, comprising a liquid spray tank, a liquid agitator rotatably mounted in said liquid spray tank, a hydraulic driving head mounted operatively on said agitator, a liquid oil tank mounted on said spray tank, dual hydraulic pump units mounted on said spray tank, power means mounted on said tank and operatively connected to said dual hydraulic pump units, means for connecting one hydraulic pump inlet with the spray tank reservoir, means for connecting [*5] the outlet of the same pump with a discharge pipe, a shut-off valve and relief valve mounted within the discharge pipe, and a spraying nozzle mounted on the end of said discharge pipe, means for connecting the other hydraulic pump inlet with the liquid oil tank, and means for connecting the same pump outlet with the inlet of the agitator driving head and return therefrom the oil tank reservoir.

The references relied on by the Patent Office are:

Dyer, 639,541, Dec. 19, 1899,

Thomson, 732,908, July 7, 1903,

Thompson, 1,755,716, Apr. 22, 1930,

Knapp, 1,759,988, May 27, 1930,

Bateman et al., 1,883,479, Oct. 18, 1932,

Brandt et al., 2,149,112, Feb. 28, 1939,

Singleton, 2,357,141, Aug. 29, 1944.

The appealed claims were rejected in the Patent Office as being unpatentable over various combinations of references. Claims 3 to 5 were rejected as unpatentable over Bateman et al. in view of Dyer or Thomson; over Thompson in view of Dyer or Thomson taken with either Brandt et al. or Bateman et al.; and over Brandt et al. Claim 5 was further rejected as unpatentable over Brandt et al. in view of Knapp, and claims 3 to 5 were also further rejected as [*6] being drawn to an old combination.

The patent to Bateman et al. discloses a power sprayer comprising a spray tank having a gasoline motor and pump mounted thereon. The motor is operatively connected in driving relationship with the pump which is connected with the tank and spray nozzles by suitable piping so that operation of the motor causes the pump to transfer the liquid spray from the tank to the spray nozzles. Bateman et al. also discloses a rotating agitator member mounted in the spray tank, the agitator being driven by an endless chain connecting the agitator shaft with a rotating power take-off shaft protruding from the pump housing. The tank is in turn mounted on a wheeled chassis so that it may be drawn by a tractor or other suitable vehicle by means of a wagon-tongue attached to the chassis.

The patent to Brandt et al. shows a power sprayer device comprising a liquid spray tank mounted on a wheeled chassis with a pushcart-type handle connected to the chassis for moving the device. Mounted on the tank are a gasoline motor and a pump, the pump being connected to the motor in driving relationship by a belt and pulley arrangement. The pump is connected with the [*7] tank and a spray nozzle by suitable piping means so that when the motor operates the pump causes the spray liquid to be transferred from tank to nozzle. There is an agitator member rotatably mounted in the tank, the agitator being driven by a cam on the pump-driving pulley which engages a gear on the agitator shaft.

The patent to Knapp discloses a power spray device having gasoline motor, pump, spray tank, and spray nozzles connected so that operation of the motor causes the spray liquid to be ejected from the spray nozzle. However, these elements are mounted on a wheeled platform rather than on the tank as in the devices of appellant, Bateman et al., and Brandt et al. Knapp teaches the use of a shut-off valve and a relief valve between the outlet side of the pump and the spray nozzle whereby spray liquid is returned to the tank if the shut-off valve is closed or excessive pressure is developed.

The patents to Dyer and Thomson disclose hydraulic driving systems for automobiles comprising an oil tank, a pump driven by a prime mover, and a hydraulic wheel driving unit, all connected by suitable piping means so that operation of the pump by the prime mover causes the wheel [*8] driving unit to operate. The hydraulic driving systems of these references are very similar to the hydraulic agitator driving system of appellant's claimed sprayer device.

For reasons to appear hereinafter, we deem it unnecessary to discuss the Thompson and Singleton references and the rejections based thereon.

The examiner, in rejecting claims 3 to 5, relied on Bateman et al. and Brandt et al. as each showing a power spray device having substantially the same elements (namely, motor, tank, pump, spray nozzles, pipe connecting means, and tank agitator with driving means) in substantially the same structural relationship and operating in essentially the same manner as in appellant's device. In his rejection of claims 3 to 5 as unpatentable over Bateman et al. in view of Dyer or Thomson, the examiner held that appellant's hydraulic agitator drive system was merely the mechanical equivalent of Bateman et al.'s chain and pulley type agitator drive system, and that no invention was involved in substituting the similar hydraulic driving [**26] system of Thomson or Dyer for the mechanical agitator drive of Bateman et al. In rejecting claims 3 to 5 as unpatentable over Brandt [*9] et al., the examiner stated that:

* * * the mechanical agitator drive means of Brandt et al. is the full equivalent of the oil tank, pump and fluid motor of appellant's device. No advantage is seen to be derived from the use of the more complicated fluid system, and thus it is considered that no inventive advance has been obtained.

In further rejecting claim 5 as unpatentable over Brandt et al. in view of Knapp, the examiner was of the opinion that use of a shut-off valve and relief valve between pump and spray nozzle of the Brandt et al. device, in the manner taught in the similar power sprayer of Knapp, "would be obvious to one skilled in the art."

The board agreed with the above-discussed holdings of the examiner and accordingly sustained the rejections. The board noted that, in view of appellant's disclosed modification wherein he shows the use of a mechanical drive similar to that shown by Bateman et al., appellant must also regard the mechanical agitator drive as the equivalent of the hydraulic agitator drive system recited in the appealed claims. The board also stated that:

* * * All that the claims define, as we understand them, is a selection of desirable [*10] features from prior art structures (admitted by Appellant) united in a single apparatus in just the way they had been used before whereby there is obtained from them merely the aggregate results that were secured in the prior art structures. Such a combination is not considered as involving invention. * * *

Appellant in his brief urges, as a patentable difference over the cited art, that his sprayer is complete in itself as a single unit, that it operates under its own power, and that it is transferable to any unit or place. Assuming that it might be inventive over the cited art to make the spray device a single portable unit, this argument by appellant has no merit in the instant case because this allegedly inventive feature is not recited in the appealed claims. The particular feature or fact upon which an applicant predicates patentability must not only be disclosed in the specification but also brought out or recited in the claims. In re Richards, 38 C.C.P.A. (Patents) 900, 187 F.2d 643, 89 USPQ 64, and cases cited therein. The recitation "and used with the farm maching [machine (?)] vehicle," in claim 1, being directly readable on each of Bateman et al., Knapp, and [*11] Thompson, it does not appear that any of the appealed claims includes recitation of any matter which appellant may rely on as bringing out this allegedly novel feature urged upon the court as a patentable difference over the cited art. Moreover, even if this

feature were properly recited in the appealed claims, as pointed out by the Solicitor of the Patent Office in his brief, this in itself would not render the claims patentable

since it is not regarded as inventive to merely make an old device portable or movable without producing any new and unexpected result. See *Ranco, Inc. v. Gwynn et al.*, 128 F.2d 437 [54 USPQ 3].

The contention discussed above is auxiliary to appellant's basic contentions. Appellant's basic contentions are that "'parts' from old patents cannot be selected as anticipation of new combinations again using them"; that each inventor is entitled to his own machine, and improvement, so long as it differs from prior art devices; and that if a new structural combination is new and useful it meets the legal requirements for "invention."

It is well settled that claims may be properly rejected on a combination of several patents taking specific features [*12] from each. In *re Kamlet*, 38 C.C.P.A. (Patents) 776, 185 F.2d 709, 88 USPQ 106 ; In *re Smith*, 34 C.C.P.A. (Patents) 1007, 161 F.2d 274, 73 USPQ 394 . It is not necessary that a complete disclosure be contained in a single reference. In *re Streckert et al.*, 35 C.C.P.A. (Patents) 1148, 167 F.2d 1010, 77 USPQ 592 ; In *re Horney*, 34 C.C.P.A. (Patents) 968, 161 F.2d 271, 73 USPQ 293 .

That a new combination of old elements may be patentable is well established. But not all new combinations are patentable. If a new combination of old elements is to be patentable, the elements must cooperate in such a manner as to produce a new, unobvious, and unexpected result. Such a combination, to be patentable, must amount to an in-

vention. In the absence of invention, utility and novelty are not sufficient to support allowance of claims for a patent. In *re Kaufmann*, 39 C.C.P.A. (Patents) 769, 193 F.2d 331, 92 USPQ 141 .

In view of the above, it appears to us that the essential question in this case is whether or not appellant exercised inventive faculty sufficient to support the allowance of claims for a patent in producing the claimed spray device by use of old and known elements.

[*13] With the exception of claim 5, which also recites shut-off and relief valves, the feature upon which appellant seeks to predicate [**27] patentability of the appealed claims is the substitution of a known type of hydraulic drive system for the mechanical agitator drive system of the primary reference patents to Bateman et al. and Brandt et al. The examiner and the board considered this change to be a mere substitution of mechanical equivalents producing no new or unexpected result, and hence they were of the opinion that such substitution did not involve

invention. A test of equivalency is whether a substituted element operates in substantially the same way to produce substantially the same result as the element replaced. In *re Husted*, 17 C.C.P.A. (Patents) 1002, 39 F.2d 713, 5 USPQ 397 . Applying this test, we are in agreement with this holding of the Patent Office tribunals. We think it significant that, as noted by the board, appellant discloses a modification of the claimed spray device wherein he shows a mechanical belt and pulley agitator drive system similar to that shown by Bateman et al. Where an applicant's

own specification indicates an equivalency between [*14] two different things, one of which is shown in the prior art, the applicant is not in a favorable position to argue that invention lies in the use of the other, although there might, perhaps, be some exceptions

in unusual circumstances. See *In re Yount*, 36 C.C.P.A. (Patents) 775, 171 F.2d 317, 80 USPQ 141, and *In re Withington*, 26 C.C.P.A. (Patents) 1290, 104 F.2d 192, 41 USPQ 742. We concur with the board's inference from this alternative disclosure that the appellant himself must have regarded the mechanical and hydraulic drives as equivalents. As to claim 5, which also recites the shut-off and relief valves, we agree with the board and the examiner that no invention was involved in the use of these features as is clearly taught in the Knapp reference, which discloses a very similar device.

In the light of the foregoing, we agree with the Board of Appeals that appellant has not displayed the exercise of invention in producing his allegedly new combination. The old and known elements used by appellant do not perform any new or unexpected function in his device; the results obtained from his allegedly new combination do not impress this court as being unobvious or unexpected.

We [*15] are therefore of the opinion that the board did not err in holding the appealed claims unpatentable on the grounds of rejection discussed above. Having reached this conclusion, we deem it unnecessary to discuss the merits of the rejection on old combination and the rejection on Thompson in view of Dyer or Thomson taken with either Brandt et al. or Bateman et al.

For the reasons hereinbefore set out, the decision of the Board of Appeals is affirmed.

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